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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Eckhard Walters

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EXAMINER

NGUYEN, DUC M

ART UNIT

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2618

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,970	<b>Applicant(s)</b> WALTERS ET AL.	
	<b>Examiner</b> DUC M. NGUYEN	<b>Art Unit</b> 2618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>9/7/06</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Information Disclosure Statement*

1. The references listed in the information disclosure statements submitted on 9/7/06 has been considered by the examiner (see attached PTO-1449).

### *Claim Objections*

1. Claims 1, 6-10 are objected to because of the following informalities:

In light of the specification, paragraph [0009], it is suggested that the claimed terms “before/after manufacturing” be changed to “before/after assembling” in order to more accurately clarify the time frame of installation of first and second memory.

Appropriate correction is required.

2. Claim 8 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 1 recites the limitation of “individual mobile terminal specific data are stored in the second memory device **after** manufacturing of the mobile terminal”. However, dependent claim 8 recites the limitation of “the individual mobile terminal specific data will be stored **during** manufacturing in the second memory device”. Accordingly, claim 8 removes the “after” limitation of independent claim 1.

***Claim Rejections - 35 USC 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims **1, 2, 10** are rejected under 35 U.S.C. 102(b) as being anticipated by **Domokos ( WO 01/89245)**.

Regarding claims **1, 10, Domokos** discloses a mobile terminal having a first processing unit, a first memory device and a SIM card chip including a second memory device the second memory device is reprogrammable, wherein the first memory device includes terminal independent data stored in the first memory device before manufacturing/assembling of the mobile terminal (see Abstract, Fig. 3, col. 7, lines 7-12 regarding microprocessor 315) and individual mobile terminal specific data are stored in the second memory device after manufacturing/assembling of the mobile terminal (see Fig. 3, col. 7, lines 13-24 and col. 4, lines 11-23 regarding the SIM card 302), which clearly depicted that the SIM card includes individual mobile terminal specific data are stored in the second memory device after assembling of the mobile terminal.

Regarding claim **2, Domokos** further discloses said individual mobile terminal specific data and user- and network specific data are stored together in the second memory device, the second memory device is further provided for storing identification data (see col. 4, lines 11-23, col. 7, lines 13-24).

***Claim Rejections - 35 USC 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims **3, 5-6, 9** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Domokos**.

Regarding claim **3**, **Domokos** would obviously, if not implicitly, disclose the terminal independent data (i.e, hard specific to supporting standards such as voice/audio coder/decoder) stored in the first memory device will never be changed during the lifetime of the mobile terminal (see col. 5, lines 2-6), for reducing manufacturing cost.

Regarding claim **5**, **Domokos** further discloses the individual mobile terminal specific data include calibration values, correction settings of high frequency parts of the mobile terminal or default values, which are depending from the individual mobile terminal (see col. 4, lines 11-23, col. 7, lines 13-24, col. 8, lines 12-22 which would obviously, if not implicitly, comprise calibration data for filters).

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Regarding claim **6**, **Domokos** discloses the second memory device is accessible for changing data after manufacturing via an interface unit or via mobile radio connection (see col. 10, lines 7-19), which would obviously suggest a user interface for the “operative coupling” or keypad 318, in order to select/change a filter in accordance with selected telecommunication network..

Regarding claim **9**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Domokos for implementing the SIM card memory in a printed circuit board of the handset, thereby providing a second memory disposed in a printed circuit board as claimed, since it has been held that forming in one piece an article which has formally been formed in two pieces and put together involves only routine skill in the art. Howard v. Detroit Stove Works, 150 U.S. 164 (1893).

6. Claims **4** is rejected under 35 U.S.C. 103(a) as being unpatentable by **Domokos** in view of **Cassidy** (US 6,480,725).

Regarding claim **4**, **Domokos** would obviously disclose the first memory device is realized as a read only memory (ROM) or as a Flash memory device and is provided for storing an operation system, application software, fixed data, start-up sequences or security settings in the similar way as disclosed by **Cassidy** (see col. 1, lines 16-20 regarding ROM), in order to store necessary parameters for the operation of the transceiver front end 310/312 and baseband 314 by microprocessor 315(see Fig. 3 and col. 7, lines 7-12).

7. Claims **7-8** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Garcia Aguilera et al** (US 5,854,976), hereafter **GA**.

Regarding claim **7**, **GA** discloses a mobile terminal having a first processing unit (control module BFC), a first memory device and a SIM card chip including a second memory device the second memory device is reprogrammable, wherein the SIM card chip is assigned uniquely to only one mobile terminal during manufacturing, wherein the mobile terminal is only operate-able with this SIM card chip having the uniquely individual mobile terminal specific data of this mobile terminal (see col. 3, line 54 – col. 4, line 15), wherein it is clear that the BFC or RAD would obviously, if not implicitly, comprise a memory device that would include terminal independent data stored in the first memory device before manufacturing/assembling of the mobile terminal, in order to process the received data for outputting audio data via speakers.

Regarding claim **8**, **Ga** would further disclose the SIM card is mechanically coupled to the mobile terminal during manufacturing, wherein the individual mobile terminal specific data will be stored during manufacturing in the second memory device (see col. 3, line 61 – col. 4, line 15).

8. Claims **1, 2, 5-6, 10** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Molne** (US 6,014,561).

Regarding claims **1, 10**, **Molne** discloses a mobile terminal having a first processing unit , a first memory device and a SIM card chip including a second memory device the second memory device is reprogrammable, wherein the first memory device

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includes terminal independent data stored in the first memory device before manufacturing or assembling of the mobile terminal (see Fig. 1, col. 4, lines 3-25, wherein the “stored program” for the microprocessor 20 would obviously comprise a memory for storing claimed “independent data” in order to control coordinates the operation of the transmitter and receiver, i.e, operating system, application software such as digital/analog voice coder) and individual mobile terminal specific data are stored in the second memory device after manufacturing/assembling of the mobile terminal (see Fig. 1 and col. 4, line 61 – col. 5, line 7, regarding the SIM card 40), which would obviously teach that the SIM card includes claimed “individual mobile terminal specific data” are stored in the second memory device after assembling of the mobile terminal (i.e, over-the-activation of a communication mode, see col. 7, line 64 – col. 8, line 32).

Regarding claims **2, 5, Molne** would teach storing parameters in the SIM as claimed (see col. 5, lines 8-22 and col. 7, lines 1-35).

Regarding claim **6, Molne** discloses the second memory device is accessible for changing data after manufacturing via an interface unit or via mobile radio connection as claimed (see col. 7, line 64 – col. 8, line 32).

9. Claims **9** are rejected under 35 U.S.C. 103(a) as being unpatentable by **Molne** (US 6,014,561) in view of **Martineau** (US 5,915,226).

Regarding claim **9**, the claim is rejected for the same reason as set forth in claim 1 above. In addition, since **Molne** is silent with a removable SIM card, **Molne** would



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obviously suggest the SIM card is permanently attached in handset (see Fig. 1) in the similar way as suggest by **Matineau** (see col. 10, 13-14). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to modify **Molne** to provide the SIM card with a memory disposed in a printed circuit board as claimed, in order to provide a compact, small size handset, noting that it has been held that forming in one piece an article which has formally been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

See the attached PTO-892.

11. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(571) 273-8300 (for **formal** communications intended for entry)

(571)-273-7893 (for informal or **draft** communications).

Hand-delivered responses should be brought to Customer Service Window,  
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

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Any inquiry concerning this communication or communications from the examiner should be directed to Duc M. Nguyen whose telephone number is (571) 272-7893, Monday-Thursday (9:00 AM - 5:00 PM).

Or to Nay Maung (Supervisor) whose telephone number is (571) 272-7882.

/Duc M. Nguyen/

Primary Examiner, Art Unit 2618

Sept 23, 2008